UNITED STATES PATENT AND TRADEMARK OFFICE

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MILDE & HOFFBERG, LLP
10 BANK STREET
SUITE 460
WHITE PLAINS, NY 10606

EXAMINER
HOM, SHICK C

ART UNIT	PAPER NUMBER
2666	

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Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/579,370	FRIEDMAN ET AL.
	Examiner	Art Unit	
	Shick C. Hom	2666	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *11/24/04 & 9/12/05*.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,2,4,6-14 and 16-24* is/are pending in the application.

     4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2,4,6-9,11-14 and 16-24* is/are rejected.

7)☒ Claim(s) *10* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

     a)☐ All   b)☐ Some * c)☐ None of:

         1.☐ Certified copies of the priority documents have been received.

         2.☐ Certified copies of the priority documents have been received in Application No. _____.

         3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

     * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
     Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
     Paper No(s)/Mail Date. _____:

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Response to Arguments

1.   Applicant's arguments filed 11/24/04 have been fully

considered but they are not persuasive.

In response to applicant's argument in page 13 regarding

claim 1, that the references fail to show certain features of

applicant's invention, it is noted that the features upon which

applicant relies (i.e., the digital data communications channel

being the Internet connection having a state independent of the

request) is not clearly recited in the rejected claim 1.

Further, applicant argued that the server of Petty et al. is not

responsive to both a set of user preferences and the state is

not persuasive because Col. 9 lines 7-33 which recite the

connection being established with the user including the

implementation of preferences and col. 2 lines 36-41 which

recite the apparatus permitting voice communications via the

Internet being independent of user location, e.g. state of

connections, clearly reads on the server being responsive to

both a set of user preferences and the state of the channel.

In response to applicant's argument in the next to last

paragraph of page 13 and the first paragraph of page 14, that

the references fail to show certain features of applicant's

invention, it is noted that the features upon which applicant
relies (i.e., communication commencing with a request from the
server to the user and opening a VoIP communication between the
user with a live agent whereby the live agent being provided
with access to the user related data and status of the
communication session between the browser and the server,
respectively) are not recited in the rejected claims 6 and 11,
respective. Although the claims are interpreted in light of the
specification, limitations from the specification are not read
into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26
USPQ2d 1057 (Fed. Cir. 1993).

In the last paragraph of page 13 of the Remarks, applicant
argued that Petty did not teach or suggest establishing the
economic interest of a party distinct from the user being
material to the establishment of the voice communication is not
persuasive because Petty in col. 6 line 55 to col. 7 line which
recite using the billing server for tracking the PSTN usage and
log distance charges and preparing call detail records for the
ISP which uses the call detail record to prepare bills for its
service subscribers clearly anticipate means for establishing
the economic interest of a party distinct from the user being
material to the establishment of the voice communication.
Further, applicant argued that Petty did not teach the

limitation of claim 5 is not persuasive because claim 5 has been

cancelled.

In page 14 of the Remarks, applicant argued that Petty does

not disclose a direct communication between the application

program and the telephony hardware nor an API call to an

external program is not persuasive, while examiner agrees that

Petty does not specifically recite a direct communication

between the application program and the telephony hardware nor

an API call to an external program, Petty in the abstract which

recites a computer telephony server controlling telephony

hardware for providing voice over Internet voice communication

including the use of a Web server clearly read on the direct

communication between the application program and the telephony

hardware and the API call to an external program whereby the

application program is the software in the computer telephony

server and the interface to the Web server is the API call to an

external program as recited in claim 17.

In pages 14-15 of the Remarks, applicant argued that Smith,

III is nonanalogous art, it has been held that a prior art

reference must either be in the field of applicant's endeavor

or, if not, then be reasonably pertinent to the particular

problem with which the applicant was concerned, in order to be

relied upon as a basis for rejection of the claimed invention.

See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir.

1992). In this case, Smith, III is pertinent to the particular

problem of facilitating access to information over the computer

network such as the Internet. Further applicant argued that

Smith III merely recite use of the Microsoft Window Explorer and

not the use of the Microsoft Windows operating system is not

persuasive because col. 6 lines 17-23 recite the use of any

major computer operating systems which clearly anticipate the

Microsoft Windows operating system.

Specification

2.   Applicant is reminded of the proper language and format for
an abstract of the disclosure.

      The abstract should be in narrative form and generally
limited to a single paragraph on a separate sheet within the
range of 50 to 150 words. It is important that the abstract not
exceed 150 words in length since the space provided for the
abstract on the computer tape used by the printer is limited.
The form and legal phraseology often used in patent claims, such
as "means" and "said," should be avoided. The abstract should
describe the disclosure sufficiently to assist readers in
deciding whether there is a need for consulting the full patent
text for details.

      The language should be clear and concise and should not
repeat information given in the title. It should avoid using
phrases which can be implied, such as, "The disclosure
concerns," "The disclosure defined by this invention," "The
disclosure describes," etc.

3.   The lengthy specification has not been checked to the
extent necessary to determine the presence of all possible minor
errors. Applicant's cooperation is requested in correcting any
errors of which applicant may become aware in the specification.

Claim Objections

4.   Claims 1, 2, 4, and 16 are objected to because of the
following informalities: In claim 1 line 5, the words "a user"
seem to refer back to the "user" recited in claim 1 line 2. If
this is true, it is suggested changing "a user" to ---the user--
-. In claim 2 line 4, the word "a public" seem to refer back to
the "public" recited in claim 1 line 11. If this is true, it is
suggested changing "a public" to ---the public---. In claim 16
line 2, the word "a voice" seem to refer back to the "voice"
recited in claim 11 line 3. If this is true, it is suggested
changing "a voice" to ---the voice---. Appropriate correction
is required.

Claim Rejections - 35 USC § 112

5.   Claims 1, 2, 4, 11-14, and 16 are rejected under 35
U.S.C. 112, second paragraph, as being indefinite for failing to
particularly point out and distinctly claim the subject matter
which applicant regards as the invention.

In claim 1 line 6 which recite "the user voice communication" lacks clear antecedent basis because no user voice communication have been previously recited in the claim and therefore the limitation is not clearly understood.

In claim 11 line 6 which recite the system comprising an application program is not clear as to how the application program is related to or connected in the system to cause communication between the user and the second party. Claims 2, 4, 12-14, and 16 are rejected under 35 U.S.C. 112, second paragraph because they depend from rejected claims 1 and 11, respectively.

Claim Rejections - 35 USC § 102

6.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7.   Claims 1, 2, 4, 6-9, 11-13, 14-17, and 19-24 are rejected

under 35 U.S.C. 102(e) as being anticipated by Petty et al.

(6,337,858).

Regarding claims 1, 17:

Petty et al. disclose the internet telephony system

comprising a browser display having a hyperlink (see Fig. 5 and

col. 9 lines 7-33 which recite the screen display for browsing

the WWW including the request for a voice connection and the

hyperlink), said hyperlink communicating with a server (see col.

7 line 65 to col. 8 line 18 which recite the web server),

retrieving a user's preferences (see col. 8 line 45 to col. 9

line 6 which recite the preference file for the user), and

initiating a voice communication with the user, through a

communications channel defined by the user preferences (see col.

10 lines 8-65 which recite the connection medium preference).

Further, Petty et al. disclose the telephony server (see col. 7

line 65 to col. 8 line 18 which recite voice communication using

a web server), comprising an application program communicating

directly with telephony hardware to implement telephony system

control (see abstract which recite the use of computer

controlled telephony hardware for voice communication and col. 6

line 55 to col. 7 line 16 which recite the software and hardware

for originating voice calls from a data network clearly reads on

the application program), and an application programming

interface, wherein said application program includes as one of

its is application programming interface functions a call to an

external program (see col. 7 lines 54-61 which recite the web

interface for ISP and subscriber administration functions

clearly reads on an application programming interface including

call to external program).

Regarding claim 6:

Petty et al. disclose the Internet telephony system

comprising a client system having an Internet browser (see Fig.

5 and col. 9 lines 7-33 which recite the screen display for

browsing the WWW including the request for a voice connection,

the hyperlink, and the client), and a server hosting a Web site

(see col. 7 line 65 to col. 8 line 18 which recite the web

server), wherein a message is transmitted from the server to the

client system based on the user's status with respect to Web

site, the seeking to establish a voice communication session

(see col. 10 lines 8-65 which recite the web server sending a

preference form to the client requesting the information when

the client requested a VoIP call connection).

Regarding claim 11:

Petty et al. disclose the Internet telephone system (see

col. 6 lines 10-29 which recite the Internet including telephone

network), comprising a browser display having a hyperlink (see

Fig. 5 and col. 9 lines 7-33 which recite the screen display for

browsing the WWW including the request for a voice connection

and the hyperlink), said hyperlink communicating with a server

(see col. 7 line 65 to col. 8 line 18 which recite the web

server), retrieving a user-related data (see col. 8 line 45 to

col. 9 line 6 which recite the preference file for the user),

and initiating a voice communication with the user (see col. 10

lines 8-65 which recite the web server sending a preference form

to the client requesting the information when the client

requested a VoIP call connection).

Regarding claims 2, 7:

Petty et al. disclose wherein said digital data

communications channel carries data between a user terminal and

a web server, the web server communicating with a distinct

server for establishing the user voice communication channel

involving a PSTN (see abstract and col. 5 line 54 to col. 6 line

9 which recite the voice communications may be voice over

Internet or PSTN voice connections).

Regarding claims 8, 14:

Petty et al. disclose wherein the user's preferences are

retrieved in a cookie (see col. 8 line 45 to col. 9 line 6 which

recite the preference file for the user including a cookie).

Regarding claims 4, 9, 12, 13, 16, 22-24:

Petty et al. disclose wherein the user interactively

communicates through the digital data communications channel to

establish the state, and the server establishing the voice

communication being further responsive to an economic interest

of a party distinct from the user; wherein the application

program interfaces with a monetary account system; a

micropayment system; and wherein the application program

supports an application service provider payment model (see col.

6 line 55 to col. 7 line which recite using the billing server

for tracking the PSTN usage and log distance charges and

preparing call detail records for the ISP which uses the call

detail record to prepare bills for its service subscribers).

Regarding claim 21:

Petty et al. disclose a communications link to a Web

server, for coordinating telephony functions and Web server

functions (see col. 6 lines 44-54 which recite the Web server

for telephony functions).

Regarding claim 19:

Petty et al. disclose wherein the application program may

spawn a plurality of instances of the external program

simultaneously (see Fig. 9A which shows the spawning of a

plurality of external program simultaneously).

Regarding claim 20:

Petty et al. disclose wherein the application program has a

component running on a telephony server and a component running

on each telephony client (see Fig. 2 and col. 6 line 55 to col.

7 line 17 which shows the software running in the server and

client).

Claim Rejections - 35 USC § 103

8.   The following is a quotation of 35 U.S.C. 103(a) which

forms the basis for all obviousness rejections set forth in this

Office action:

> (a) A patent may not be obtained though the invention is not identically
> disclosed or described as set forth in section 102 of this title, if the
> differences between the subject matter sought to be patented and the prior
> art are such that the subject matter as a whole would have been obvious at
> the time the invention was made to a person having ordinary skill in the
> art to which said subject matter pertains. Patentability shall not be
> negatived by the manner in which the invention was made.

9.   This application currently names joint inventors. In

considering patentability of the claims under 35 U.S.C. 103(a),

the examiner presumes that the subject matter of the various

claims was commonly owned at the time any inventions covered

therein were made absent any evidence to the contrary.

Applicant is advised of the obligation under 37 CFR 1.56 to

point out the inventor and invention dates of each claim that

was not commonly owned at the time a later invention was made in

order for the examiner to consider the applicability of 35

U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior

art under 35 U.S.C. 103(a).

10.   Claim 18 is rejected under 35 U.S.C. 103(a) as being

unpatentable over Petty et al. (6,337,858) in view of Smith, III

(6,772,139).

Regarding claim 18:

For claim 18, Petty et al. disclose the telephony system

and server described in paragraph 7 of this office action. For

claims 18-20, Petty et al. disclose all the subject matter of

the claimed invention with the exception of wherein the

application program is a dynamic link library adapted to run

under Microsoft Windows as in claim 18.

Smith, III from the same or similar fields of endeavor

teach that it is known to provide wherein the application

program is a dynamic link library adapted to run under Microsoft

Windows (see col. 9 lines 13-28). Thus, it would have been

obvious to the person having ordinary skill in the art at the

time the invention was made to provide wherein the application

program is a dynamic link library adapted to run under Microsoft

Windows as taught by Smith, III in the telephony system and

server of Petty et al. The application program being a dynamic

link library adapted to run under Microsoft Windows can be

implemented by providing the Microsoft Windows operating system

software in the browser software of Petty et al. The motivation

for providing the application program being a dynamic link

library adapted to run under Microsoft Windows as taught by

Smith III in the system and device of Petty et al. being that it

provides more efficiency for the system since the system is

using the well know Microsoft Windows operating system for

operation efficiency of the system.

Allowable Subject Matter

11. Claim 10 would be allowable if rewritten to include all of

the limitations of the base claim and any intervening claims.

Conclusion

12. Applicant's amendment necessitated the new ground(s) of

rejection presented in this Office action. Accordingly, **THIS

ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is

reminded of the extension of time policy as set forth in 37

CFR 1.136(a).

A shortened statutory period for reply to this final action

is set to expire THREE MONTHS from the mailing date of this

action. In the event a first reply is filed within TWO MONTHS

of the mailing date of this final action and the advisory action

is not mailed until after the end of the THREE-MONTH shortened

statutory period, then the shortened statutory period will

expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated

from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than

SIX MONTHS from the date of this final action.

13. Any inquiry concerning this communication or earlier

communications from the examiner should be directed to Shick C.

Hom whose telephone number is 571-272-3173. The examiner can

normally be reached on Monday to Friday with alternate Fridays

off.

   If attempts to reach the examiner by telephone are

unsuccessful, the examiner's supervisor, Seema Rao can be

reached on 571-272-3174. The fax phone number for the

organization where this application or proceeding is assigned is

571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SH

DANG TON
PRIMARY EXAMINER